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In re Application of
KNIGHT et al.
U.S. Application No.: 10/540,042
PCT No.: PCT/EP03/14786
Int. Filing Date: 23 December 2003
Priority Date: 23 December 2002
Attorney Docket No.: 4245-107
For: APPARATUS AND METHOD FOR
STORING PROTEINS

DECISION ON PETITION
UNDER 37 CFR 1.47(a)

This decision is in response to applicants' "Petition for Acceptance of Declaration and Power of Attorney Executed by Assignee on Behalf of Non-Signing Inventor under 37 CFR 1.47(b). ." filed 25 April 2006, which is being treated as a petition under 37 CFR 1.47(a) to accept the application without the signature of joint-inventor, Larissa Pinnock. The \$200 petition fee has been submitted.

BACKGROUND

On 23 December 2003, applicants filed international application PCT/EP03/14786 which claimed a priority date of 23 December 2002. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 08 July 2004. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States expired at midnight on 23 June 2005.

On 22 June 2005, applicants filed a transmittal letter for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a copy of the international application; and a preliminary amendment.

On 21 November 2005, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

On 25 April 2006, applicants filed the present petition.

DISCUSSION

A filing under 37 CFR 1.47(b) and 35 U.S.C. 118 is permitted only when no inventor is available to make application. Therefore, applicant's petition will be treated under 37 CFR 1.47(a). A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the non-signing joint inventor. Item (1) and (3) have been satisfied.

Regarding item (2) above, petitioner states that Larissa Pinnock has refused to sign the application. Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), **Proof of Unavailability or Refusal**, states, in part:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Regarding item (2) above, a review of the present petition reveals that petitioner has not satisfied item (2), in that, petitioner has not provided sufficient proof that the inventor refuses to execute the application. Michael Rheinnecker states that "Attorney Robert Harrison contacted Larissa Pinnock by letter dated November 3, 2004. . . Larissa

Pinnock responded to such November 3, 2004 letter by correspondence dated December 17, 2004, communicating her refusal to sign such declaration." However, petitioner fails to provide documentary evidence of Larissa Pinnock's refusal. As stated above, when there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. Lastly, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made, i.e. Robert Harrison.

Regarding item (4) above, section 409.03(a) of the Manual of Patent Examining Practice (MPEP) states that:

An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

In this case, applicants filed a declaration executed by the first named inventor and assignee of the above identified application. A declaration executed by the assignee is necessary only when there is no inventor available. Therefore, applicants must submit newly executed declarations executed by the cooperating inventor and containing unsigned signature blocks for the nonsigning inventor. Such a declaration can then be treated as having been executed by the available inventor on their own behalf and on behalf of the nonsigning inventors. Until such declaration is submitted, item (4) is not satisfied.

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to: Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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